UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,264	05/11/2001	Susan M. Garthwaite	01-597	8255

7590 11/12/2003

Steven J. Sarussi
McDonnell Boehnen Hulbert & Berghoff
32nd Floor
300 S. Wacker Drive
Chicago, IL 60606

EXAMINER	
SHEIKH, HUMERA N	

ART UNIT	PAPER NUMBER
1615	12

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/854,264	Applicant(s) GARTHWAITE ET AL.	
	Examiner Humera N. Sheikh	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-13 and 23-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-13 and 23-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Status of the Application

Receipt of the Amendment filed 09/08/03 is acknowledged.

Claims 9-13 and 23-27 are pending. New claims 23-27 have been added. Claims 9-13 and 23-27 are rejected.

Inventorship

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9-13 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devane *et al.* (US Pat. No. 6,228,398; hereafter '398) in combination with Grob *et al.* (US 4,559,332; hereafter '332) and further in combination with Jao *et al.* (US 5,160,744; hereafter '744) OR Faour *et al.* (US 6,569,456; hereafter '456) in combination with Grob *et al.* (US 4,559,332; hereafter '332) and further in combination with Jao *et al.* (US 5,160,744; hereafter '744).

'398 and '456 both teach controlled release anti-hypertension combination formulations that provide both immediate release and controlled release of the active agents. Neither reference teaches that the anti-hypertensive agent is an aldosterone antagonist or release of the active agent in accordance with the diurnal cycle of plasma aldosterone concentration.

'332 teaches aldosterone antagonists as potassium-saving diuretics for treatment of hypertension but does not teach the combination of the aldosterone antagonist with a second formulation having a second anti-hypertensive agent.

'744 teaches administration of delayed release anti-hypertensive agents at bedtime to block the early morning rise of blood pressure.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to provide an anti-hypertensive formulation having two anti-hypertensive agents where the formulation releases one of the agents in accordance with the early morning rise of blood pressure and one of the agents is an aldosterone antagonist with the motivation that substitution of an aldosterone antagonist for one of the anti-hypertensive agents of either '398 or '456 would result in the same effect (i.e., reduction of hypertension) while sparing potassium and avoiding the early morning rise of blood pressure.

These rejections are maintained and applied to newly added claims 23-27.

The prior art teaches aldosterone antagonists and anti-hypertensive combination formulations in distinct release forms comprising aldosterone antagonist drugs, such as eplerenone (see Jao et al. '332), for the effective treatment of hypertension.

Response to Argum nts

Applicant's arguments filed 09/08/03 have been fully considered but they are not persuasive.

Firstly, the applicant argued, "Applicants respectfully disagree with the claim rejections and submit that the Office is improperly engaging in hindsight reconstruction based on Applicant's disclosure".

This argument has been fully considered, but was not found to be persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Secondly, the applicant argued, "There is no suggestion or motivation in the cited references to combine the references in the manner suggested by the Office. The references do not discuss or suggest the desirability of providing a composition containing a delayed release formulation of an aldosterone antagonist that provides a drug concentration corresponding to the diurnal cycle of plasma aldosterone concentration. The references do not even mention or contemplate the diurnal cycle of plasma aldosterone concentration."

These arguments have been fully considered, but were not found to be persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the '398 and '456 patents both teach controlled release anti-hypertension combination formulations that provide both immediate release and controlled release of the active agents. Neither reference teaches that the anti-hypertensive agent is an aldosterone antagonist or release of the active agent in accordance with the diurnal cycle of plasma aldosterone concentration. The '332 was relied upon for the generic teaching of aldosterone antagonists as potassium-saving diuretics for treatment of hypertension. This patent does not explicitly teach the combination of the aldosterone antagonist with a second formulation having a second anti-hypertensive agent. The '744 patent was relied upon for the teaching of an administration of delayed release anti-hypertensive agents at bedtime to block the early morning rise of blood pressure. The applicants' argument that the references do not mention the diurnal cycle of plasma aldosterone concentration was not found to be persuasive since the prior art teaches various forms of release, such as controlled, delayed and immediate release of anti-hypertensive agents at bedtime to block the early morning rise of blood pressure. One skilled in this

art would further be able to determine suitable cycles for plasma aldosterone concentration through the use of routine experimentation based on the desired or intended time for drug delivery.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (703)

308-4429. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

hns
November 10, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600